



Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
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Paper No. 7

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OFFICE OF PETITIONS

In re Application of :
Yin Cheng et al :
Application No. 09/707,770 :
Filed: November 8, 2000 :
Attorney Docket No. 003636.0103 :

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the "Petition Under 37 CFR 1.47(a), filed August 13, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2) set forth above.

The petition states that a diligent effort on the part of the firm and the assignee, Aether Systems, Inc., has been expended in trying to locate nonsigning inventor Cheng. In this regard, the petition sets forth the following attempts to locate nonsigning inventor Yin Cheng: (1) by mailing the declaration and assignment by U.S. Certified Mail, Return Receipt Requested, and Federal Express to two last known addresses, both of which were returned as "Addressee Unknown; (2) forwarding of the declaration and assignment to inventor Cheng to an e-mail address provided by a previous co-worker; and (3) attempts to contact inventor Cheng at her last known phone number. Further, the petition states that, according to Jasmine Stephens, of legal personnel of Assignee, there is a possibility that inventor Cheng has relocated to China at an unknown address.

As to item (1), where inability to find or locate a named inventor is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of fact must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.

The applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor. See MPEP 409.03(a). While it is appreciated that several attempts have been made to locate nonsigning inventor Cheng, at the present time, the evidence is not considered to constitute adequate proof that all possible efforts have been expended in an effort to locate inventor Cheng such that the declaration can be accepted under 37 CFR 1.47(a). In this regard, while the petition indicates that the assignee, Aether Systems, Inc., has made a diligent effort to locate the inventor, there is no indication whether inventor Cheng's employee records were accessed and, if so, what did inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? Since the petition indicates that inventor Cheng may have relocated to China, has petitioner attempted to locate inventor in any regional or national registry(s) or by other means, such as the Internet and Lexis.com?¹ Copies of the results of the search must be referred to in any renewed petition. See MPEP 409.03(d). If inventor Cheng is located, then a complete copy of the application papers (specification, claims, drawings, oath, etc.) should be mailed to inventor's Cheng's address, return receipt requested, along with a cover letter of instructions which includes a deadline

¹ A brief search on Lexis.com indicated several addresses for a Yin Cheng.

or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

If the inventor is located and the inventor orally refuses to join in the application, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

As to item (2), the declaration is defective in that it has been altered. In this regard, the block for the first named inventor has the name Yan Hang crossed through it and printed beside it is the name of inventor Yin Cheng. Since the declaration cannot be amended, a new declaration is required that is not altered or amended and that clearly sets forth the inventive entity of this application.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-8680.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy